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| 10/634,990      | 08/06/2003  | Dennis Wayne Rice    | 103864.134US1       | 7455             |

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NEW YORK, NY 10022

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| EXAMINER |
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EDWARDS, LAURA ESTELLE

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| ART UNIT | PAPER NUMBER |
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1734

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|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

08/10/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/634,990

Applicant(s)

RICE ET AL.

Examiner

Laura Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34-41, 43-61, 68, 70 and 72-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34/35, 36, 38, 39, 40, 46, 47, 53, 54, 55; 37; 41; 43/44, 45; 50/51, 52; 56/57, 58; 68; and 70/72, 73, and 74 is/are allowed.
- 6) ☒ Claim(s) 48, 49 and 59-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

***Specification***

The disclosure is objected to because of the following informalities:

1) The first page and first few lines of the specification need to be updated to reflect --US Patent No. 6,892,512--.

2) In the Brief Description of the Drawings, ending on page 15, there was no mention whatsoever of Appendix A-1 and Appendix A-2. These appendices appear to be part of the drawings as evidenced by the page numbering. Also, there appeared to be no mention of an appendix in the specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 48 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 48, line 1, "the label securing section" lacks antecedent basis.

In claim 49, line 1, "the at least one surface securing section" lacks antecedent basis.

***Established State of the Art***

It is well established in the art of packaged medicine to place medicine in a folded or foldable package wherein the medicine is contained therein with the package including a jacket, booklets, and labeling as evidenced by Hulick et al (US 5,915,559), see col. 2, lines 20+; specifically that that package can include labeling, col. 3, lines 24-28.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vijuk (US 6,273,411) in view of Fattal et al (US 4,927,486) for reasoning substantially set forth in the previous office action.

Additionally with respect to amended claim 59, the combination of teachings of Vijuk and Fattal et al do not explicitly set forth that the rotational type reducing means reduces the label such that the barcode on the label maintains visibility for later scanning. However, it would have been obvious to one of ordinary skill in the art to provide in the arrangement defined by the combination above, the maintenance of visibility of the barcode to ensure correct positioning of the label throughout processing. The barcode reader would still allow the user to automatically detect if there is a problem with the label being in the correct position as such would be within the purview of one skilled in the art.

***Allowable Subject Matter***

Claims 48 and 49 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 34/35, 36, 38, 39, 40, 46, 47, 53, 54, 55 would be allowable.

Independent claim 37 would be allowable.

Independent claim 41 would be allowable.

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Claims 43/44, 45 would be allowable.

Claims 50/51, and 52 would be allowable.

Claims 56/57, 58 would be allowable.

Independent claim 68 would be allowable.

Claims 70/72, 73, and 74 would be allowable.

### ***Response to Arguments***

Applicants' argument(s) filed 3/30/07 has/have been fully considered but they are not persuasive.

Applicants contend that the patent to Vijuk (US 6,273,411) is directed to a booklet forming apparatus while the patent to Fattal et al (US 4,927,486) relates to a system for applying labels to pallets such that there is no motivation to combine the teachings of booklet making with pallet labeling to result in a labeling system for usage in labeling patient specific pharmaceuticals and/or patient orders. This argument is well taken in that it would not appear that the two patents to Vijuk and Fattal would be combinable but both relate to labeling systems which when combined would structurally read on the claimed invention. The fact that Vijuk is manipulating or using a booklet in the system would not preclude the usage in said system of a booklet or folded article containing medicine. It is common sense and well established that medicine can be placed in a container or booklet form such as in a foldable package as evidenced by Hulick et (applied for argument sake only). The system of Vijuk would thereby be capable of labeling a booklet containing medicine therein. The limitation not taught by Vijuk, including the bar code reader, has been supplied by Fattal for reasons of allowing the user to determine if the correct

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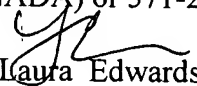
label has been applied and the label is in the correct position. The proper motivation for the combination has been supplied as required by *Graham v. Deere*. The limitations of claim 59 including applicable depending claims would be too broad to warrant a grant of patentability.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Laura Edwards  
Primary Examiner  
Art Unit 1734

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August 3, 2007